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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,614	01/30/2004	Hidehiko Ogawa	P24507	5641

7055 7590 09/19/2005

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,614	Applicant(s) OGAWA, HIDEHIKO	
	Examiner Thomas D. Lee	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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DETAILED ACTION

Response to Amendment

1. This Office action is responsive to applicant's amendment, filed June 30, 2005.

Claims 1-11 are pending.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,710,894 (Ogawa) in view of U.S. Patent 5,798,845 (Baek et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the pending claims 1-5, and newly added claim 16, of the application and the allowed claims of the patent is that a memory in the application is configured to store default information, while the memory in the patent is configured to store information regarding an identification of a user of the image data communication apparatus. In the application, default information is set into the mail

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message of an e-mail to which image data is attached when the information regarding the identification of the user is not selected by the panel section. However, it is well known in the art that a memory that stores user identification numbers for the transmission of image data can also store a default number, and that this default number can be attached to image information to be transmitted to a receiver when a user identification number is not entered. Baek et al. disclose this limitation (column 7, lines 44-67 (the default number is the automatic dialing number "FF")). It would have been obvious to one of ordinary skill in the art that by providing a default number, a user may be able to transmit image data, either on behalf of himself or herself, or on behalf of the company for which he or she works, and that a person receiving the image data can positively identify the company sending the image data even if a user at the transmitting end fails to enter identification information. It is irrelevant that Baek et al. is not an *Internet* facsimile apparatus, for one of ordinary skill in the art, in view of Baek et al., would have recognized that the benefits obtained by providing storage of default information along with user identification information may be applied in *any* type of communication apparatus which transmits image data, so that a receiver may be informed of the sender of such data.

4. Furthermore, with regard to pending claims 6 and 7, the method steps are performed by the apparatus of patent claims 1 and 5, respectively, with the exception of the storing and setting of default information, which, as related above, would have been an obvious modification to one of ordinary skill in the art. Moreover, pending claims 8-

11 further recite a transmitter (claim 8) and corresponding transmission step (claim 10), which reads on lines 2-6 of patent claim 1 and lines 3-4 of patent claim 5, respectively.

Response to Arguments

5. Applicant's arguments filed in response to the rejection of claims 1-15 as set forth in the prior Office action have been fully considered but they are not persuasive.

Applicant asserts that the patent claims of the parent (Ogawa) do not recite a memory that stores default information, or a controller that sets the default information into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is not selected by the panel section, or a controller that sets the information regarding the identification of the user selected by the panel section into the mail message of the e-mail to which the image data is attached when the information regarding the identification of the user is input (amendment, at page 8, third paragraph). However, memory for storing default information is disclosed in Baek et al., and the controller for setting the default information and the information regarding the identification of the user would have been rendered obvious in view of Baek et al., as set forth in the above rejection. Applicant asserts that Baek et al. relates to an ordinary facsimile apparatus, not an Internet facsimile apparatus, and thus does not render the claimed controller obvious (amendment, at page 9, fourth paragraph). However, as mentioned above, it is irrelevant that Baek et al. is not an Internet facsimile apparatus, for one of ordinary skill in the art, in view of Baek et al., would have recognized that the benefits obtained by providing storage of default information along with user identification information may be

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applied in *any* type of communication apparatus which transmits image data, so that a receiver may be informed of the sender of such data.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
September 15, 2005